

**Remarks/Arguments**

Claims 1, 3-5, 9, 11 and 12 are pending.

**Rejection of claims 1, 3-5, 9, 11 and 12 under 35 USC 103(a) as being unpatentable over Graves (US Pat No 5410344) in view of Bruette (US Pat No 5694176)**

The previous rejection of the claims under 35 USC 103(a) in view of Graves has been withdrawn. However, a new grounds of rejection is made under 35 USC 103(a) over Graves in view of Bruette.

Applicant respectfully traverses these rejections, and request reconsideration of the pending claims for at least the following reasons.

35 U.S.C. §103(a) sets forth in part:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

To establish a prima facie case of obviousness, all of the recited claim limitations must be taught or suggested in the prior art. *See, MPEP 2143.03; see also, In re. Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).* Further, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. *See, M.P.E.P. 706.02(j).* Further yet, the teaching or suggestion to make the claimed combination must be found in the prior art, and not based on the applicant's own disclosure. *In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).*

Applicant respectfully submits: (1) the cited prior art fails to teach, or suggest, all of the recited limitations of the pending claims; and, (2) a proper motivation and reasonable expectation of success for combining the teachings of Graves and Bruette in the manner suggested is lacking for at least the following reasons.

The Office Action acknowledges that Graves fails to meet the limitation "... directly comparing a particular characteristic of the program information of a highest rated one of the numerous programs for which rating information is received with a corresponding characteristic of the program information for a plurality of programs from a listing of programs in response to the suggestion signal, and suggesting all programs from the plurality of programs in which the characteristic of the program information substantially matches the particular characteristic of the program information of the highest rated one of the numerous programs" of claim 1.

The Office Action states that "the viewer's preference file in Graves is made up of a plurality of characteristics, which is broader than the claimed, 'a particular characteristic.'" Applicants submit that the preference files of Graves is not necessarily broader than the 'particular characteristic' according to claim 1, but rather the preference file, and the method of filtering as taught by Graves is clearly **different** from the particular characteristic and the method of filtering according to the present invention.

As discussed in applicants' previous response, Graves teaches a system that generates a grade based on a plurality of characteristics using a hierarchical analytic decision making process. That is, Graves teaches "... screening incoming programs and selecting those with the highest interest to a viewer based on the viewer's personal preferences regarding numerous program attributes." (col. 7, lines 57-60, emphasis added) Such a filtering method is implemented using adaptive, neural networks (col. 7, lines 62-67).

By contrast, the present invention relies on a direct comparison with a "particular characteristic" rather than a comparison of a factor that is derived from multiple characteristics. Such differences may result in different results being provided to the user.

The Office Action cites Bruette to cure the defect of Graves as applied to claim 1. However, applicants submit that the combined teachings of Graves and Bruette still fail to meet all the limitations of claim 1.

Bruette teaches an apparatus for generating television program guides, wherein a user can select a certain category of programs for display in the program guide. In response to user selection of a particular category (as shown in

Fig. 3(a)), the system provides further sub-menus (Figs. 3(a)-3(d)) that allow the user to further narrow the programs selected for display. The categories include, for example, Movies, Sports, Specials, Series, News, and Shopping Fig. 3(a). The categories in the sub-menus include, for example, time periods (Fig. 3(b)), certain program classes (Fig. 3(c)), and programs from various channel lists (Fig. 3(d)). Col. 4, line 24 - col. 5, line 54 mention these menus and describe the selection of the options within these menus.

Clearly, Bruette fails to teach or suggest "directly comparing a particular characteristic of the program information of a highest rated one of the numerous programs for which rating information is received with a corresponding characteristic of the program information for a plurality of programs from a listing of programs in response to the suggestion signal, and suggesting all programs from the plurality of programs in which the characteristic of the program information substantially matches the particular characteristic of the program information of the highest rated one of the numerous programs" recited in claim 1.

Bruette says nothing about receiving **rating formation from the user**, comparing program information based on the received rating information, and suggesting programs in response to the comparison. The programs selected for display in Bruette have nothing to do with rating information from the user. Rather, Bruette provides a **program listing** in which the programs are selected entirely on the basis of the category, or sub-category selected by the user. These categories and sub-categories do not reflect ratings information provided by the user and do not take these rating information into account to make program suggestions to the user.

Therefore, the combination of Bruette and Graves would result in a system that provides **program suggestions** based on the filtering method taught by Graves and also provides a **program listing** based on the category and sub-category selected by the user as taught Bruette. Such a system still fails to provide the above-mentioned feature of claim 1.


Furthermore, applicants submit that nothing in Bruette or Graves provides the necessary motivation or expectation of success for the combination suggested by the Office Action. Bruette is directed to a system that provides program suggestions to a user based on information about the user. Graves, by contrast, is

directed to a system for generating a user interface that provides menus and program information in a manner to minimize the possibility of a viewer becoming losing within the guide (col. 2, lines 1-9; col. 2, lines 30-37). Thus, Bruette and Graves relate to entirely different problems and solutions, and nothing in either reference teach or suggest combining the systems in the manner suggested by the Office Action. In view of the above, applicant submit that present claim 1, and the claims that depend therefrom, are patentably distinguishable over the teachings of the cited combination of references.

Claim 9 recites the above-mentioned limitations of claim 1 in apparatus form. Thus, applicants submit that claim 9, and the claims that depend therefrom, are patentably distinguishable over the cited combination of references for at least the same reasons as those discussed above.

Having fully addressed the Examiner's rejections it is believed that, in view of the preceding amendments and remarks, this application stands in condition for allowance. Accordingly then, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the applicant's attorney at (609) 734-6815, so that a mutually convenient date and time for a telephonic interview may be scheduled.

Respectfully submitted,  
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